IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

SEAL, D. et al.   Atty. Ref.: 550-509

Serial No. 10/781,883   Group: 2183

Filed: February 20, 2004   Examiner: Fennema

For: INSTRUCTION ENCODING WITHIN A DATA PROCESSING
     APPARATUS HAVING MULTIPLE INSTRUCTION SETS

Before the Board of Patent Appeals and Interferences

REPLY BRIEF FOR APPELLANT
On Appeal From Final Rejection
From Group Art Unit 2183

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October 15, 2008

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This is a reply to the Examiner's Answer dated August 19, 2008, and

specifically addresses the new points[1] raised therein.

The Examiner argues that the claimed first instruction set and second

instruction set can be interpreted as encompassing systems with only a single

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[1] The Examiner cites for the first time several definitions of the term subset from
"dictionary.com" and an "Altair 8800" reference. In addition, the Sherer, Kroesche, and
Chang references are cited on page 3 of the Answer as being "Evidence Relied Upon."
Appellants do not believe Sherer, Kroesche, and Chang are part of the rejections on
appeal.

instruction set. This interpretation is unreasonable.

The "broadest reasonable interpretation" does not necessarily mean any interpretation or definition. It must be reasonable when interpreted by one of ordinary skill in the art in light of the claims context, the other claims, and the specification. "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). It is the use of the words in the context of the patent application and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338 (Fed. Cir. 2003).

In construing or interpreting a claim term, the patent's intrinsic evidence should be examined primarily. *See Phillips*, 415 F.3d at 1312; *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 861 (Fed. Cir. 2004). This intrinsic evidence includes the claims themselves, the specification, and the prosecution history. *See Phillips*, 415 F.3d at 1314; *C.R. Bard, Inc.*, 388 F.3d at 861. The claims themselves provide substantial guidance in determining the meaning of particular claim terms. *Phillips*, 415 F.3d at 1314. A claim term's context in the asserted claim can be very instructive. *Id.* Other claims can also aid in determining the claim's meaning because claim terms are typically used consistently throughout

the patent. *Id.* "[C]laims 'must be read in view of the specification, of which they are a part.'" *Id.* (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc)). "[T]he specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.'" *Id.* (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002).

When each independent claim is read as a whole in context and in light of the other claims and the specification, i.e., the intrinsic evidence, it is clear that the first instruction set and second instruction set are <u>two</u> different instruction sets to which the instruction decoder is responsive. Each of the independent claims recites that the first and second instructions sets have a "common subset of program instructions." The "common subset of program instructions" means there are two instructions sets that are sufficiently different; otherwise, it would not make sense to introduce the feature of a common subset. To read them as the same instruction set, as the Examiner does, is inconsistent with the other language in the independent claims relating to the common subset.

In addition, dependent claims 5, 16, and 27 each recite that the first instruction set is a <u>fixed length</u> instruction set of N-bit instructions, while claims 7, 18, and 29 each recite that the second instruction set is a <u>variable length</u> instruction set. These dependent claims make it clear that the first and second

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instruction sets are not the same. Thus, the Examiner's interpretation is inconsistent with features recited in these dependent claims.

The Examiner's interpretation is also inconsistent with the embodiments described in the present application, as the Examiner's Answer rightly admits. Thus the Examiner's position is directly at odds with the statement quoted above from the Federal Circuit that the specification is always highly relevant to claim construction, that it is usually dispositive, and that "it is the single best guide to the meaning of a disputed term." *Id.* While it is true that specific details cannot be imported from specific embodiments, it is also true the claims may not be interpreted in a way that is inconsistent with the specification, as the Examiner does by interpreting the first and second instruction sets as the same instruction set.

The Examiner seeks to make an analogy to two different situations involving two barrels. In a first situation, the first barrel contains apples and the second barrel contains apples as well. In a second situation, the first barrel contains apples and the second barrel contains oranges. But what the Examiner overlooks is that in both of these situations there are two different barrels. The Examiner's analogy is not reasonable if there is only a single barrel of apples. But that is the situation here on appeal because there is only a single instruction set in Qureshi.

To further understand the weakness of the Examiner's position, consider the first and second instruction sets to which the instruction decoder is responsive
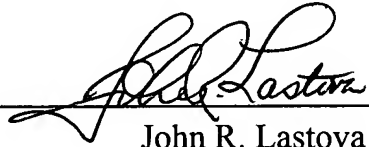
as analogous two languages which the instruction decoder understands. If a person says that he/she speaks a first language and a second language, all reasonable interpretations of this statement would be that those two languages are different. When a person says that he/she speaks a first and a second language, this not an ambiguous statement where one wonders whether the person means two different languages or the same language.

With regard to the "subset" claim construction, if the claims as properly interpreted recite two instruction sets, then the overlapping subset cannot be the entirety of each of the two instruction sets because otherwise the two instruction sets would be the same. As demonstrated above and in the main Brief, the first and second instruction sets are not the same. Extrinsic evidence is "'less significant than the intrinsic record in determining the legally operative meaning of claim language.'" *Phillips*, 415 F.3d at 1317 (quoting *C.R. Bard, Inc.*, 388 F.3d at 862). The Board is reminded of the Federal Circuit's caution that technical dictionaries may provide definitions that are too broad or may not be indicative of how the term is used in the patent. *Id*. at 1318. That is the case with the Examiner's interpretation of subset.

The final rejections should be reversed for the reasons explained above and set forth in the main Brief.

Respectfully submitted,

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